Suing the Osbournes: Intellectual Property Protection for Creative Merchandise

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SUING THE OSBOURNES: INTELLECTUAL PROPERTY PROTECTION FOR CREATIVE MERCHANDISE

I. INTRODUCTION

"Anna Nicole ate my little brother." "Bin Laden is a big fat doodiehead." "Brittany is a whore." These are just a few of the offensive t-shirt messages you will find at tshirthell.com. T-Shirt Hell, Inc. ("T-Shirt Hell") is an online t-shirt company that profits from its off-color comments regarding celebrities and current events. T-Shirt Hell's web site enables its visitors to purchase t-shirts online and to submit their own ideas for provocative t-shirt phrases. The company's t-shirt phrases range from political mockery to obscene celebrity critique. Although many of the shirts are capable of causing controversy, one shirt in particular has thrust this online company into the legal spotlight. The shirt at issue reads, "FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES!"

The infamous t-shirt draws its humor from MTV's hit television show "The Osbournes." The reality-based sitcom follows the lives of heavy metal legend Ozzy Osbourne and his rock-and-roll family. The selling point of "The Osbournes" is the uniquely humorous lifestyle that the dysfunctional family leads. Ozzy's previous battles with drugs and alcohol have left him in a

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4. Id.
6. Id.
vulnerable and peculiar state. His constant mumbling, swearing, and inability to perform some of the most basic household tasks have kept Americans laughing. Other hilarious elements of the show include Ozzy's children who constantly bicker, and his dozens of pets that roam the house defecating on his pricey furnishings. After only one season, America was hooked and the Osbournes became one of the most recognized families in American culture.

In May of 2002, T-Shirt Hell filed suit against the Osbournes and several other defendants for infringing their t-shirt slogan “FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES.” The complaint alleged that the defendants authorized the manufacture and sale of t-shirts bearing a similar slogan, which resulted in trademark infringement and unfair competition. The impetus for this Article came from this ironic lawsuit. It seems that a celebrity should have the right to profit off of his own name. This Article will evaluate the merit of T-Shirt Hell’s legal claims against the Osbournes. The overall objective of this Article is to consider whether creative merchandise is capable of acquiring intellectual property protection.

T-shirts, coffee cups, hats and other souvenirs often contain lucrative phrases. It is these creative words that persuade the consumer to buy the otherwise ordinary merchandise. It seems there should be some way to protect these profitable phrases from the blatant copying and unjust enrichment of others. However, much uncertainty exists regarding the legal protections available for creative merchandise. One of the primary reasons for this uncertainty is that creative merchandise and t-shirt phrases do not clearly fall within a specific area of intellectual property. Still, protection for such merchandise is not totally out of the question.

7. Id.
8. Id.
9. Id.
10. Id.
12. Id. at 3.
This Article is organized into four main sections. Part II will discuss relevant background information regarding trademark and copyright law, right of publicity, and unfair competition. In this section, the requirements for acquiring each type of intellectual property protection will be discussed as well as the proof required for establishing infringement. The complaint filed by T-shirt Hell will also be discussed in greater detail. In Part III, the phrase at issue, “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES,” will be analyzed to determine if it qualifies for trademark or copyright protection. The validity of T-Shirt Hell’s unfair competition and trademark infringement claims will also be considered. Additionally, the analysis will suggest possible conflicts between T-Shirt Hell’s phrase and the Osbournes’ right of publicity. In Part IV, the impact of the Osbourne case will be discussed as it applies to the intellectual property protections available for creative merchandise.

II BACKGROUND

This section will begin with a basic discussion of trademark law and the Lanham Act. Relevant cases will be explored to demonstrate how t-shirt phrases fail to meet some of the most fundamental trademark requirements. Statutory limitations concerning the content of trademarks will also be considered.

Next, the Copyright Act will be discussed as well as the different elements a work must possess in order to acquire copyright protection. Case law will be examined for its discussion on the copyrightability of jokes and other short phrases. Additionally, the requisite proof for establishing copyright infringement will be set forth.

Third, the right of publicity will be discussed. Again, relevant case law will be examined to illustrate when the court has found a violation of this intellectual property right. Finally, the principles behind unfair competition will be briefly discussed.

13. See infra notes 14-190 and accompanying text.
A. Trademark Protection

The term trademark is defined as any “word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.” A trademark is the owner’s way of preventing others from tricking consumers into buying a product they mistakenly believe is sponsored by the trademark owner. Not every word or phrase functions as a trademark. To qualify as a mark, the term or slogan must communicate a single source for the goods in question. Trademarks also convey information about the product’s or service’s nature and quality. A critical element in determining whether a term functions as a trademark is the impression that the term makes on the relevant public.

14. See In re Remington Products, Inc., No. 493,829, 1987 TTAB LEXIS 91 (stating “mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark”). Id. at *4.

15. See New Kids on the Block v. News Am. Publ’g, Inc., 971 F.2d 302, 305 (9th Cir. 1992).

16. See Remington, 1987 TTAB LEXIS 91 at *3-4 (citing In re Morganroth, 208 U.S.P.Q 284 (TTAB 1990)). See also ROCHELLE COOPER DREYFUSS & ROBERTA ROSENTHAL KWALL, INTELLECTUAL PROPERTY: CASES AND MATERIALS ON TRADEMARK, COPYRIGHT AND PATENT LAW 7 (1996). See Mattel, Inc., v. MCA Records Inc., 296 F.3d 894 (9th Cir. 2002). A trademark informs people that the trademarked products come from the same source. The core purpose of a trademark is to prevent consumer confusion in the marketplace. Id. at 900.


18. See Remington, 1987 TTAB LEXIS 91. Here, the Board considered whether the slogan “PROUDLY MADE IN THE USA” functioned as a trademark. Id. at *1. The Board inquired into whether the term was perceived as a source indicator or merely an informational slogan. Id. at *2. The Board held that the applicant’s slogan merely conveyed information to the public about the products locale of manufacture. Id. at *5. The inclusion of the word “PROUDLY” simply added further information about the state of mind of the manufacturer and its employees in connection with the goods. Id. Since purchasers would not recognize the slogan as a source indicator, the slogan was not registerable. Id. at *7.
1. Protection for T-Shirt Phrases

In *In re Pro-Line Corporation*¹⁹, the Trademark Trial and Appeal Board explicitly discussed the functional requirement of a trademark as it applied to t-shirt phrases. In its analysis, the Board discussed how t-shirts are often ornamented with various insignia, including college insignia, or various sayings.²⁰ The Board explained that if such ornamentation had no other meaning, it could not serve as indicia of source.²¹ However, the Board recognized that matter which serves as part of the aesthetic ornamentation of goods could be registered as a trademark if it also serves as a source-indicator.

Here, the applicant sought to register the phrase “BLACKER THE COLLEGE SWEETER THE KNOWLEDGE.”²² The phrase appeared on t-shirts in large, bold letters that immediately caught the eye.²³ The phrase was meant to promote the value of an education at the institutions listed in small type below.²⁴ The Board held that the applicant’s phrase was primarily an ornamental slogan.²⁵ The applicant argued that because the shirt also displayed the term “PRO-LINE,” the source of the goods, the

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²⁰. *Id.* at *2.
²¹. *Id.* at *4. The applicant can submit evidence showing that purchasers recognize the ornamental matter as an indication of the source of the goods. Such evidence includes promotion of the ornamental matter as a mark and survey evidence demonstrating purchaser perception of the matter as a mark. *See In re David Crystal, Inc., 296 F.2d 771 (1961).*
²³. *Id.* The Board explained that where an alleged mark serves as part of the aesthetic ornamentation of goods, the size, location, dominance and significance of the alleged mark as applied to the goods are all factors that figure prominently in the determination of whether it also serves as an indication of source. *Id.*
²⁴. *Id.*
²⁵. *Id.* at *10. The Board found no evidence that the slogan “BLACKER THE COLLEGE SWEETER THE KNOWLEDGE” was distinctive for any other goods or services, such that the distinctiveness carried over to use on collateral products.
The phrase was source indicative. The Board rejected this argument on the grounds that the applicant was seeking to register the phrase "BLACKER THE COLLEGE SWEETER THE KNOWLEDGE" not "PRO-LINE." Therefore, the signaling capacity of "PRO-LINE" was irrelevant. The Board held that the applicant’s phrase was primarily ornamental and, therefore, unregisterable.

*In re Astro Gods* is another case where the Trademark Trial and Appeal Board addressed the concept of trademark protection for t-shirt phrases. Here, the Board discussed the functional requirement as it applied to a hypothetical t-shirt displaying the phrase "Swallow Your Leader." The Board explained that such a saying would probably not be considered source indicative. However, the Board recognized that the “ornamentation” of a t-shirt could be of a special nature that it inherently tells the purchasing public the secondary source of the t-shirt.

In its discussion, the Board referred to another hypothetical t-shirt on which the name “New York University” appeared. The Board explained that the name, along with an illustration of the hall of fame, would serve as ornamentation and would also advise the purchaser that the university was the secondary source of that shirt. According to the Board, matter that serves as part of the aesthetic ornamentation of goods can still be registered if it also serves a source indicating function. Ornamental matter can be source indicative if: (1) it names the secondary source of the goods; or (2) at the time of its first use as ornamentation, it was already a recognized trademark of the applicant for services or other goods.

26. *Id.* at *6.
28. *Id.*
29. *Id.* at *10.
31. *Id.* at 623.
32. *Id.*
33. *Id.*
34. *Id.* (citing *In re Olin Corp.*, 181 U.S.P.Q. 182 (TTAB 1973); *In re Paramount Pictures Corp.*, 213 U.S.P.Q. 1111 (TTAB 1982) and cases cited therein). Here, the Board held that the applicant’s phrase, “ASTRO GODS” and
2. Protection for Phrases On Other Merchandise

In *Damn I’m Good, Inc. v. Sakowitz,* the United States District Court for the Southern District of New York considered the phrase “DAMN I’M GOOD” as a trademark for jewelry. The plaintiff sought to enjoin the defendants from infringing this mark by advertising, distributing or selling goods using the phrase “DAMN I’M GOOD.” The court determined that the phrase was not source indicative and, therefore, failed to function as a trademark. The court reasoned that the purchasers of the plaintiff’s jewelry were primarily motivated by the aesthetically pleasing phrase because the underlying jewelry was rather ordinary. The court clarified “there is no such thing as a property in a trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed” and “the right to a particular mark grows out of its use (to designate the product of a particular trader), not its mere adoption.” The court held that others could freely appropriate the phrase.

In the aforementioned cases the courts have reinforced the principles that trademark law was designed to protect. Fundamental to trademark protection is a mark's source-signaling design, was not a recognized trademark at the time it was first used ornamentally on t-shirts. Furthermore, the applicant had not properly promoted the phrase in connection with the t-shirts so as to create consumer recognition of it as a trademark. The Board delineated several factors to be considered in determining whether an alleged mark that serves as part of the aesthetic ornamentation of goods also serves as an indication of origin. These factors include the size, location, dominance, and significance of the alleged mark as applied to the goods. After considering these factors, the Board sided with the Examining Attorney, ruling that the designation “ASTRO GODS” and design were not likely to be perceived as anything more than part of the thematic whole of the ornamentation of the applicant’s shirts. 

36. Id. at 1358.
37. Id. at 1363.
38. Id. at 1362.
39. Id.
40. Id.
capacity. One of the primary objectives of trademark law is to avoid consumer confusion in the marketplace.\textsuperscript{42} If a mark does not convey source information, there is no consumer confusion to prevent.

3. Statutory Content Restrictions

Even if a phrase functions as a trademark, protection could still be denied due to statutory content restrictions. Section 2(a) precludes the registration of a trademark that "consists of or comprises... scandalous matter."\textsuperscript{43} The Trademark Trial and Appeal Board attempted to set forth the parameters of "scandalous matter."\textsuperscript{44} \textit{In re Tinseltown, Inc.}\textsuperscript{45} discussed the validity of the mark "BULLSHIT" for attaché cases, handbags, purses, belts and wallets. The Trademark Trial and Appeal Board held that the profane word was scandalous within the meaning of Section 2(a).\textsuperscript{46} In rejecting the mark, the Board relied on two dictionary definitions of the term scandalous: (1) "giving offense to the conscience or moral feelings..." and (2) "shocking to the sense of... decency or propriety...."\textsuperscript{47} The Board reasoned that even

\textsuperscript{42} See Mattel, 296 F.3d at 900.
\textsuperscript{43} 15 U.S.C.A. §1052.
\textsuperscript{44} See \textit{In re McGinley}, 211 U.S.P.Q. 668 (CCPA 1981). The Trademark Trial and Appeal Board’s reviewing court expressed its opinion that section 2(a) of the Trademark Act does not represent "an attempt to legislate morality, but, rather a judgment by Congress that such marks not occupy the time, services and use of funds of the federal government." \textit{Id.} at 673.
\textsuperscript{46} \textit{Id.} at 865. \textit{See also} Greyhound Corp. v. Both Worlds, Inc., 6 USPQ 1635 (TTAB 1988). Here, the Trademark Trial and Appeal Board determined that a design consisting of the silhouette of a defecating dog, as a mark for polo shirts and t-shirts was scandalous. The Board noted in particular the depiction of feces as part of the mark.
\textsuperscript{47} \textit{Tinseltown}, at 865. These definitions were presented in \textit{McGinley}, 211 U.S.P.Q. at 673. In McGinley, the court was considering the registrability of a photograph of a man and woman kissing and embracing in a manner appearing to expose the man’s genitalia. After interpreting the meaning of scandalous, the court held that this photograph fell within its parameters and thus was an unregistrable mark. \textit{Id.} at 673.
though profane words may be uttered more freely, this does not render them any less profane.\textsuperscript{48}

In \textit{Old Glory Condom Corp.},\textsuperscript{49} the Trademark Trial and Appeal Board considered whether the use of the American flag as part of the applicant's mark for condoms was scandalous. The American flag design appeared as a feature of the applicant's trademark for condoms but was not present on the condoms themselves.\textsuperscript{50} The examiner refused registration of the mark on the ground that a majority of the American public would be offended by the use of American flag imagery to promote products associated with sexual activity.\textsuperscript{51} The applicant argued that his design was not meant to offend but rather to redefine patriotism as including the fight against sexually transmitted diseases.\textsuperscript{52} The Board considered precedent and acknowledged that marks which were considered scandalous twenty years ago might now be perceived as humorous.\textsuperscript{53} Recognizing that society's attitude changes through time, the Board held that the "context of contemporary attitudes" must be considered when determining whether a mark is scandalous.\textsuperscript{54}

\begin{itemize}
\item \textsuperscript{48} \textit{Tinseltown}, at 865. The Board also pointed out that the fact that profane words may be uttered more freely does not amend the statute by which the Board must determine registerability.
\item \textsuperscript{49} 26 U.S.P.Q.2d (BNA) 1216 (TTAB 1993).
\item \textsuperscript{50} \textit{Id}. at *3.
\item \textsuperscript{51} \textit{Id}.
\item \textsuperscript{52} \textit{Id}. at *4.
\item \textsuperscript{53} \textit{Id}. at *11. The Board reversed the refusal to register because the applicant's mark was not scandalous within the meaning of section 2(a). The Board heavily relied on the applicant's serious purpose with which the mark was employed. The applicant marketed his condoms in packaging that emphasized his commitment to the sale of high quality condoms as a means of promoting safer sex and eliminating AIDS. \textit{Id}. at 17. The Board explained that a "seriousness of purpose made manifest to purchasers on the packaging for applicant's goods is a factor to be taken into account in assessing whether the mark is offensive or shocking." \textit{Id}. at 18.
\item \textsuperscript{54} The Board also explained that the mark's offensiveness should be judged in the context of the mark's entire use including labels and accompanying designs. \textit{See In re Hershey}, 6 U.S.P.Q.2d 1470 (TTAB 1988). Here, the Board considered the mark "BIG PECKER BRAND" for t-shirts. The examiner had
Marks will also be deemed un registrable if they identify matter of a living individual. Section 2(c) of the Lanham Act precludes the registration of marks which "consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent . . . ." A name is likely to identify an individual if that person "is so well known that the public would reasonably assume the connection, or if the individual is publicly connected with the business in which the mark is used." For purposes of Section 2(c), an identifying name can be a full name, surname, nickname, or other shortened name.

B. Copyright Protection

The United States Constitution grants Congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." This exclusive right was intended to serve as an incentive for authors to contribute to the public domain. The Board reversed the refusal of registration. The Board reasoned that, because the label used the phrase in conjunction with a design of a bird, it did not offend morality or raise a scandal.

56. Id.
57. See In re Debbie Sauer, No. 73/822,435, 1993 TTAB Lexis 12. Here, the Trademark Trial and Appeal Board considered the registerability of the mark "BO BALL." The examiner refused registration under sections 2(a) and 2(c) of the Lanham Act. Id. at *1. The refusal under section 2(a) of the Act was based on the contention that the mark falsely suggested a connection with Bo Jackson. The refusal under section 2(c) was based on the fact that the mark consisted of a name identifying Mr. Jackson and thus could not be registered by the applicant without Mr. Jackson's written consent. Id. The Board affirmed the refusals on both grounds reasoning that Mr. Jackson's fame in the football and baseball industry could cause consumers to assume he was connected to the applicant's goods. Id. at *7. The Board relied on the facts that Mr. Jackson was widely known by his nickname and had commercially endorsed other products. Id.
58. Id. at *6.
However, the primary purpose of granting copyright protection is not to reward the author but, rather, to secure "the general benefits derived by the public from the labors of the authors." Copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.

The current copyright statute (hereinafter the 1976 Act) became effective on January 1, 1978. Unlike its predecessor, the 1909 Act, the present act does not require an author to undergo all of the formalities in order to receive copyright protection. Under the

60. See MELVIN B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHTS § 1.03 [A], at 1-66.17 (2002).
61. Id. at 1-66.17 to 1-66.18, n.3 (citing Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975). (“Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability to literature, music and other arts. The immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive to stimulate artistic creativity for the general public good”).
62. See Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 556-67 (1985). Copyright may be claimed only in the “expression” of a work of authorship and not in its “idea.” See Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc., 797 F.2d 1222, 1234 (3d Cir. 1986); See also NIMMER, supra note 60, § 2.03[D], at 234. (quoting section 102(b) of the present Copyright Act: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such a work”).
63. See MELVIN B. NIMMER & DAVID NIMMER, 2 NIMMER ON COPYRIGHTS §7.16[A][1], at 7-147 (2002).
64. See DREYFUSS & KWALL, supra note 16, at 233-34. Part of the reason why Congress decided to de-emphasize certain formalities for copyright protection was in response to the Berne Convention. Berne is an international copyright treaty, which promotes the view that copyright formalities should not be required in order to receive protection. Many of the provisions of the 1909 Act were inconsistent with Berne, and would have precluded the U.S. from adhering to the treaty if we so decided. Additionally, certain real world consequences made adhering to the formalities overly burdensome for copyright owners. Authors and artists often lack the financial resources and legal help that inventors and trademark holders have at their disposal, hence the term “starving
1976 Act, a work receives protection from the moment it is created. An author’s copyright protection will last throughout their lifetime plus an additional seventy years. When the period of copyright protection expires the work becomes part of the public domain to be enjoyed freely by all.

Under the 1976 Act, copyright protection is accorded to “original works of authorship fixed in any tangible medium of expression.” Thus three elements must be present for copyright protection: (1) originality; (2) authorship, and (3) fixation. Originality is a constitutional requirement and a fundamental element of authorship. To be deemed original, the work must be independently created by the author and possess a minimal degree of creativity. The requirement of fixation is met “when its embodiment in a copy or phonorecord . . . is sufficiently permanent . . . to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory artist.” Uncounseled, they would often lose their rights unintentionally. In providing protection for authors and artists from the moment of creation, rather than upon publication and notice, the 1976 Act reduces this risk.

For works created on and after January 1, 1978, the effective date of the Current Copyright Act, registration is not a condition to obtaining a copyright. Copyright automatically attaches to a work the moment it is created, which means “when it is fixed in a copy or phonorecord for the first time.” See Nimmer, supra note 63, § 7.16[A][1], at 7-147.

Previous law granted protection for the life of the author plus an additional 50 years. The Sonny Bono Copyright Term Extension Act, which provided protection for the author’s life plus 70 years, was supported on the ground that it gave copyright holders an incentive to preserve older works, particularly motion pictures in need of restoration. Once this term expires, the work of art becomes part of the public domain. See Nimmer, supra note 60, § 1.05[A][1], at 1-66.24, n.6.2e.

An author has been defined as “he to whom anything owes its origin; originator, maker.” See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

The requirement of fixation is met “when its embodiment in a copy or phonorecord . . . is sufficiently permanent . . . to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory
Simply, a work is fixed when it is made permanent in some form of tangible medium.

1. Copyrightable Subject Matter

Section 102(a) enumerates the different categories that constitute "works of authorship." Copyrightable subject matter includes: literary works, musical works, dramatic works, pantomimes and choreographic works, motion pictures and other audiovisual works, sound recordings and architectural works. "Literary works are works ... expressed in words, numbers, or other verbal or numerical symbols ... such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards in which they are embodied."

Section 102(a)(5) specifically addresses copyright protection for prints and labels used for articles of merchandise. Copyright Office Circular No. 46 described a print as an artistic work with or without accompanying text, published in a periodical or used separately in connection with the sale or advertisement of an article or articles of merchandise. The Circular distinguished prints from labels explaining that the latter consists of either artistic or literary work that is either imprinted on or attached to an article of merchandise or its container. In the event that a label...
consists solely of text, it might also find protection as a literary work. Unlike trademark law, copyright protection is not predicated on the content of the writing. In *Mitchell Brothers Film Group v. Cinema Adult Theater*, the United States Court of Appeals for the Fifth Circuit held a work could not be precluded from copyright protection based on its content. *Mitchell* remains the prevailing view even though previous courts have held that obscene content precludes copyright protection. According to *Mitchell*, Congress intended that all creative works be accorded protection. The court reasoned that the public taste would reward creators of useful works and deny creators of useless works any reward. Even works deemed seditious, libelous, fraudulent or deceptive would not be denied copyright protection under *Mitchell*.

### i. Protection for Short Phrases

In *Kitchens of Sara Lee Inc., v. Nifty Foods Corp.*, the United States Court of Appeals for the Second Circuit simply stated that “prints and labels” generally refers to single-page works that contain copyrightable pictoral matter, text, or both and which are published as advertising or as labels for goods. *Id.* at 2-134.

81. “Despite the House Report suggestion that prints or labels used for articles of merchandise are protectable under the ‘pictoral, graphic, and sculptural works’ category, it would appear that textual matter on labels should be regarded as literary works.” See NIMMER *supra* note 60, § 2.08[G][2], at 2-135.

82. 604 F.2d 852 (5th Cir. 1979). The court expressly held that obscene content does not exclude a work from copyright protection because an obscenity restriction would be antiethical to the promotion of creativity. *Id.* at 856. The court reasoned that creativity requires freedom to explore into the gray areas, to the cutting edge, and even beyond. *Id.*

83. See NIMMER, *supra* note 60, § 2.17, at 2-197.


85. *Id.*

86. *Id.*

87. 266 F.2d 541 (2d Cir. 1959). Here, the plaintiff and defendant both bake and sell bakery products including chocolate cake, cream cheese cake, pound cake and coffee cake. *Id.* at 543. The defendant was accused of copying the
States Court of Appeals for the Second Circuit delineated limitations regarding the copyright protection available for textual matter. The court stated that, "brand names, trade names, slogans and other short phrases or expressions could not be copyrighted, even if they are distinctly arranged or printed." Several courts have denied copyright protection for fragmentary words or phrases due to their lack of creativity. In most of these cases, the short phrase at issue consisted of only one or two words. Still, it may be possible for a short phrase to acquire copyright protection if it exhibits sufficient creativity. "There appears to be a reciprocal relationship between creativity and independent effort." The theory is that "short phrases require less effort from the author" and, therefore, "a greater degree of creativity must be shown in order to claim copyright protection."

Jokes are an example of short phrases that have been held copyrightable. Like all copyrightable works, the joke must be original and protection is limited to the joke's expression as drawings of the chocolate cake, cheesecake and pound cake from the plaintiff's labels. The court entertained arguments that questioned the copyrightability of pictures of domestic articles of food. Nonetheless, the court held that such obvious copying should be discouraged. The court explained that the plaintiff had put time, creative thought and money into its pictorial representation of its cakes and for the copying the plaintiff was entitled to damages.

88. Id. at 544.
91. See NIMMER, supra note 60, §2.01[B], at 2-17.
92. Id.
opposed to its mere idea. Because the value of a joke often derives from its idea rather than its expression, its potential for receiving copyright protection is often limited. Still, there have been instances where an idea was uniquely expressed and, therefore, accorded a high level of protection. In Foxworthy v. Custom Tees, the plaintiff comedian brought an action against the defendant t-shirt manufacturer for allegedly infringing his common-law copyright in the phrase “you might be a redneck” and his copyrighted redneck jokes.

The defendants argued that the jokes were not original to the plaintiff and, therefore, the plaintiff should be prevented from claiming authorship. The defendants explained that the plaintiff got the ideas for his jokes from others causing his work to consist of public domain material authored by many people. The United

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94. See NIMMER, supra note 60, §2.13, at 2-178.3.
97. The plaintiff, a comedian, was famous for his “you might be a redneck if... jokes.” Id. at 1204. Examples of the plaintiff’s jokes include “You might be a redneck if... your dad walks you to school because you’re in the same grade” and “You might be a redneck if... you’ve ever financed a tattoo.” Id. The plaintiff sold comedy albums, t-shirts, and calendars all based on his redneck jokes. Id. In December of 1994, the plaintiff became aware that t-shirts bearing exact replications of his jokes were being sold in various stores across the country. Id. The only difference between the plaintiff’s jokes and the replications was the format. Id. The defendants t-shirts phrased the jokes in reverse order reading “If you’ve ever financed a tattoo... you might be a redneck.” Id.
98. Id. at 1217.
99. Id. at 1218. The United States District Court for the Northern District of Georgia explained that the defendant’s argument misinterprets the elements of authorship and originality. Id. An individual can still be the author of an original work even if that work was based on material that came from the public domain. Id. Originality and authorship simply require that an author independently express this material in an original way. Id. To be deemed original, the work must possess at least a minimal degree of creativity. Id. The requisite level of creativity is extremely low. The vast majority of works will possess some kind of creative spark. Id. (citing Feist Publications v. Rural Telephone Service Co., 499 U.S. 340, 344 (1991)).
States District Court for the Northern District of Georgia rejected the defendant's argument on the ground that it was the plaintiff who took these ideas and gave them expression. The court explained that copyright is concerned with the originality of the expression as opposed to the subject matter. The plaintiff's motion to enjoin the defendants from further infringement was granted.

2. Infringement

A copyright owner has the exclusive right to "reproduce, distribute, perform and display the work" as well as the "right to prepare derivative works based on the underlying protected work." If any person exercises one of these exclusive rights without the authorization of the copyright owner, an infringement

100. Foxworthy, 879 F. Supp. at 1219. The court made reference to the plaintiff's testimony regarding the difficulty of writing a joke. Id. The plaintiff explained that the goal is to get the maximum amount of laughter from the shortest amount of material. Id. Meeting this objective entails constant fumbling with the wording of a joke. Id. Comedians will debate about which word to put first and which to put last, getting the wording correct is key to the success of a joke. Id.

101. Id. The court stressed that ideas are not the substance of copyrights. No author can ever copyright the ideas or facts he narrates. Id. at 1218. (citing Feist, 499 U.S. at 344). However, an author is entitled to protect his or her original expression of these ideas. The plaintiff repeatedly stated that he used other people's ideas. Still, the plaintiff was the one to put those ideas into his own words. As such, his expression was copyrightable. Id.

102. Id. at 1220. When a plaintiff makes a prima facie showing of either trademark or copyright infringement, irreparable harm is ordinarily presumed. Id. at 1219. In balancing the hardships, the court found in favor of the plaintiff. Id. Forcing the plaintiff to compete with an infringer outweighed the defendant's inability to sell illegally infringing t-shirts. Id. Public interest was also found to tip in favor of the plaintiff. Id. The court explained that the public's interest is served when the law is upheld and enforced. Id. Enforcing the exclusive rights of authors promotes the constitutionally recognized value of art and science to the citizens of this country. Id.

103. 17 U.S.C. § 106. For a more detailed discussion of these rights see Nimmer, supra note 63 §§ 8.02 to 8.20, at 8-27 to 8-283.
suit may be brought. Although registration is not required under the 1976 Act to receive protection, registration remains a prerequisite for instituting an infringement action.

To establish infringement, the plaintiff must prove two elements: (1) ownership of a valid copyright, and (2) copying of original elements of the work. A plaintiff can establish copying by showing that the defendant had access to the plaintiff’s work and that the works are substantially similar. In the case of literary works, infringement is not limited to verbatim copying of the text but also considers whether the part taken was substantial. Access to a copyrighted work can be inferred when

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104. “The Act’s reference to an “action for copyright infringement” extends to all copyright infringement actions, including counterclaims, even if the only relief sought is an injunction.” See Nimmer, supra note 63, § 7.16[B][1][a], at 7-153. Once registration occurs, a subsequent infringement action may address infringing acts that occurred after or before registration, provided that the filing of the infringement action occurs within the term set in the statute of limitations. Id.

105. To apply for registration, an author must submit three materials to the copyright office: (1) a completed application form; (2) copies of the work; and (3) a filing fee of twenty dollars. The submission of copies of the author’s work is not a requirement for copyright protection. However, failure to satisfy the deposit requirement will result in a fine. See 17 U.S.C. § 407(d).

106. An exception is made for infringements occurring during the first three months after a work is published if registration is made before the end of the three months. See 17 U.S.C. § 412. If an applicant has been refused registration, she can still maintain an infringement action under section 411(a). Section 411(a) allows an action to be brought if “deposit, application and fee have been delivered to the Copyright Office in proper form and registration has been refused.

107. See Feist, 499 U.S. at 359.


109. See Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930). Balanced against this principle is the countervailing consideration that copyright does not protect against the borrowing of abstract ideas. If the only similarity between the plaintiff’s and the defendant’s works is an abstract idea, there is
the defendant has had a reasonable opportunity to view the plaintiff's work before creating his or her own work.\textsuperscript{110}

\textbf{C. The Right of Publicity}

Judge Jerome Frank coined the term "right of publicity" in the 1953 case \textit{Haelan Laboratories v. Topps Chewing Gum, Inc.}\textsuperscript{111} Here, the United States Court of Appeals for the Second Circuit recognized that in addition to a right of privacy, a man has a right in the publicity value of his photograph.\textsuperscript{112} In this case, the plaintiff entered into a contract with a ball-player providing the plaintiff with the exclusive right to use the ball-player's photograph for the sale of chewing gum.\textsuperscript{113} The ball-player agreed not to grant any other gum manufacturer the right to use his photograph for the entire term of the contract.\textsuperscript{114} However, the ball-player subsequently entered into a similar contract with the defendant.\textsuperscript{115} The court ruled that the plaintiff had a valid claim against the defendant if the defendant used the ball-player's photograph during the term of the plaintiff's contract.\textsuperscript{116} In its analysis, the court recognized the pecuniary value inherent in a celebrity's image.\textsuperscript{117} The court went on to say that this right of publicity would not be profitable unless it could be made the subject of an exclusive grant barring all other advertisers from its use.\textsuperscript{118}

\textsuperscript{110} See \textit{Arica}, 770 F. Supp. at 191.
\textsuperscript{111} 202 F.2d 866 (1953).
\textsuperscript{112} \textit{Id.} at 868.
\textsuperscript{113} \textit{Id.} at 867.
\textsuperscript{114} \textit{Id.}
\textsuperscript{115} \textit{Id.}
\textsuperscript{116} \textit{Haelan}, 202 F.2d at 868.
\textsuperscript{117} The court said that it was common knowledge that many prominent persons, especially actors and ball-players, would feel deprived if they did not receive money for their endorsements. \textit{Id.}
\textsuperscript{118} \textit{Id.}

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1. State Publicity Rights

Over the past fifty years, the right of publicity has become more pronounced. Currently, most states recognize that a celebrity’s right of publicity has economic value. State law determines the parameters of this property right. The right of publicity has many of the same qualities as other forms of personal property, such as the ability to possess and control the property to the exclusion of others. The right of publicity can also be the subject of a contract and can be assigned to others. Currently, fifteen states recognize a postmortem right of publicity.

i. New York and California

New York’s right of publicity law is unique when compared with other states. Although the court in Haelan recognized a common law right of publicity, the court later rejected this

119. The right of publicity has developed to protect the commercial interest of celebrities in their identities. The theory is that a celebrity’s identity can be valuable in the promotion of products. Accordingly, the celebrity is entitled to protect their identity from unauthorized commercial exploitation. See Memphis Dev. Found. v. Factors Etc., Inc., 616 F.2d 217 (1980). The court stated that, during their lifetime, celebrities have the exclusive right to control and profit from the commercial use of their name and persona.

120. Under either common law or statute, the right of publicity has been recognized as the law of twenty-seven states. States which recognize the right of publicity under common law are: Alabama, Arizona, California, Connecticut, Florida, Georgia, Hawaii, Illinois, Kentucky, Michigan, Minnesota, Missouri, New Jersey, Ohio, Pennsylvania, Texas, Utah and Wisconsin. See J. THOMAS McCARTHY, 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:16, at 28-25 (4th ed. 1996).

121. See McCARTHY, supra note 120, §§ 28:16 to 28:39, at 28-25 to 28-40 for more information about state law sources of right of publicity law.

122. Id.

123. An assignment is an outright sale of the right of publicity conveying all rights to the assignee. Id. § 28:47, at 28-67.

124. Eleven states recognize this right by statute and four by common law. Id. § 28:45, at 28-64.

125. Haelan, 202 F.2d at 868.
holding. In 1984, the court held that the right of publicity is encompassed under the Civil Rights Laws as an aspect of the right of privacy.\textsuperscript{126} Since the right of privacy is exclusively statutory in New York, the plaintiff cannot claim an independent common law right of publicity.\textsuperscript{127}

Conversely, California has taken a more liberal approach to their right of publicity legislation. Aside from recognizing a common law right of publicity for living persons,\textsuperscript{128} the state also enacted a statute recognizing a post mortem right of publicity.\textsuperscript{129} Additionally, California has a statute that recognizes a claim for invasion of appropriation privacy and infringement of the right of publicity for living persons.\textsuperscript{130} These additional statutes supplement common law rights.\textsuperscript{131}

\begin{footnotes}
\begin{enumerate}
\item Id. at 174. For a more detailed discussion of New York’s right of publicity law see MCCARTHY, supra note 120, §§ 28:31 to 28:39, at 28-43 to 28-55.
\item See Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988). Here, the United States Court of Appeals for the Ninth Circuit rejected Bette Midler’s section 3344 claim. Midler’s claim involved a Ford television commercial that used a Midler sound-alike to sing one of her famous songs. Because the voice used was not Midler’s, the court rejected her claim reasoning that the defendants had not used anything prohibited by the statute. The term likeness refers to a visual image as opposed to a vocal imitation. Id. at 463. Still, the court recognized that Midler had stated a claim for violation of her common law right of publicity because “the defendants . . . for their own profit in selling their product did appropriate part of her identity” by imitating her voice. Id. at 463-64.
\item See MCCARTHY, supra note 120, § 28:18, at 28-26 to 28-28.
\item In 1999, the Governor signed into law a package of amendments bringing about three major changes to the California provisions creating a post mortem right: (1) the amendments rephrased the statutory exemptions for the media; (2) the term of post mortem right was extended from 50 years to 70 years; (3) a new provision was added claiming adjudication whenever the acts creating a claim occurred in California. See MCCARTHY, supra note 120, § 28:18, at 28-26.
\item A defendant may still infringe a plaintiff’s common law right even though the indicia the defendant used does not fall within the statutory list. For a more detailed discussion of California’s right of publicity law see MCCARTHY, supra note 120, §§ 28:18 to 28:30.
\end{enumerate}
\end{footnotes}
2. Infringement

A prima facie case for infringement of the right of publicity requires that the plaintiff plead and prove two elements. First, the plaintiff must prove the validity of their right. In order to satisfy this burden of proof, the plaintiff’s own identity must be at issue or the plaintiff must be an assignee or exclusive licensee of someone else’s right of publicity. Second, the plaintiff must demonstrate infringement. Infringement is established if the defendant, without permission, used some aspect of the identity or persona in such a way as to identify the plaintiff. Additionally, the plaintiff must show that the defendant’s use is likely to cause damage to the commercial value of their persona.

Infringement of the right of publicity is governed by the test of “identifiability.” When a significant number of people can identify the person in question from the defendant’s unpermitted commercial use, infringement is triggered. No proof of falsity, confusion, or deception is required to prove right of publicity infringement.

132. See McCARTHY, supra note 120, § 28:7.
133. Id.
134. Id. § 28:7, at 28-9, n.1.
135. Id. The right of publicity does not require that the appropriation of identity be accomplished through particular means to be actionable. It is not important how the defendant has appropriated the plaintiff’s identity, but whether the defendant has done so. A rule that limits infringement to only nine methods of appropriation merely challenges the clever advertiser to come up with the tenth. Id. § 28:18, at 28-28
136. The term persona is used to refer to the different commercial values embodied in personal identity. Persona encompasses a name, nickname, voice, picture, performing style, distinctive costume or character, and other indicia closely identified with a person. The protected elements of persona may be limited to name and likeness depending on the statute. See McCARTHY, supra note 120, § 28:7, at 28-10.
137. Id.
138. Falsity or deception is not required for right of publicity infringement. Rather, infringement is triggered if the plaintiff is identifiable from the defendant's unauthorized use. Id.
139. See McCARTHY, supra note 120, § 28:12 at 28-14.
In John W. Carson et al. v. Here’s Johnny Portable Toilets, the United States Court of Appeals for the Sixth Circuit held that the defendant’s phrase identified Carson even though his name, John W. Carson, or his picture were not used. Here, the celebrity plaintiff Carson was the host and star of a well-known television show called “The Tonight Show.” Five nights a week, starting in 1962, Carson was introduced on each show with the phrase “Here’s Johnny.” Thus the phrase, “Here’s Johnny” came to be associated with Carson by most of the television viewing public.

The defendant was a corporation engaged in the business of renting and selling “Here’s Johnny” portable toilets. The defendant was aware of the “Here’s Johnny” introductory slogan at the time he formed his corporation. He admitted that he used the slogan “Here’s Johnny” together with the phrase “The World’s Foremost Commodian” to make a good play on words. The district court’s judgment, dismissing Carson’s common law right of publicity claim, was vacated. The court explained that the district court’s conception of the right of publicity was too narrow. The court held that a celebrity’s right of publicity is invaded whenever his identity is commercially exploited regardless of whether or not his name or likeness is used.

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140. 698 F.2d 831 (6th Cir. 1983).
141. Id. at 835. A celebrity’s right of publicity is invaded whenever his identity is appropriated for commercial purposes.
142. Id. at 832.
143. Id.
144. Id.
145. Carson, 698 F.2d at 833.
146. Id.
147. Id. at 832
148. Id. at 835. The District Court dismissed Carson’s common law right of publicity claim because the defendants had not used Carson’s “name or likeness.” In reversing this decision the Sixth Circuit found that the right was implicated because the defendant had appropriated Carson’s identity by using the phrase “Here’s Johnny!” Id. at 835-37.
149. Id. at 837.
i. 43(a) Claims

Although falsity is not necessary to establish right of publicity infringement, falsity is required for a 43(a) claim. Section 43(a) of the Lanham Act prohibits false advertising, which makes it an effective vehicle for alleging claims of false sponsorship and endorsement. Often the unpermitted use of a celebrity’s identity will suggest a false inference of endorsement or sponsorship and hence trigger false advertising concerns in addition to infringing upon the right of publicity.

In *White v. Samsung Electronics America, Inc.*, the United States Court of Appeals for the Ninth Circuit applied the likelihood of confusion analysis to determine whether White could prevail on her 43(a) claim. The theory behind the likelihood of confusion analysis is that the public believes that the mark’s owner sponsored or otherwise approved the use of the trademark. In *White*, the defendant electronics company ran an advertisement that depicted a robot dressed in a wig, gown and jewelry purposely selected to represent the plaintiff’s “Wheel of Fortune” television persona. The robot was positioned next to a game Board, and the caption below read “Longest running game show.” White did not consent to this ad nor was she paid for it.

In determining whether the defendants’ ad created a likelihood of confusion as to the endorsement of their product, the Court of Appeals for the Ninth Circuit applied a trademark-type eight-factor analysis.

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151. *Id.*
152. 971 F.2d 1395 (9th Cir. 1992).
153. The United States District Court for the Central District of California granted summary judgment to the defendants and White appealed. *Id.* at 1397. The United States Court of Appeals for the Ninth Circuit affirmed in part, reversed in part and remanded. *Id.* at 1402.
155. *White*, 971 F.2d at 1396.
156. *Id.*
157. *Id.*
analysis considering (1) strength of the plaintiff’s mark; (2) relatedness of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) likely degree of purchaser care; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines.  

The court in White clarified that when the mark involves a celebrity’s identity, the first factor, “strength of the mark,” refers to the level of recognition the celebrity enjoys among members of society. Also, in determining intent, the seventh factor, the relevant question is whether the defendant intended to profit by confusing consumers. In its application of the first factor, the court found that White’s mark or celebrity identity, was strong. In considering the defendant’s intent, the court found that a jury could reasonably conclude that beneath the surface humor was intent to persuade consumers that White had endorsed the products. 

The sixth factor, likely degree of purchaser care, was also held to favor White. The court found that consumers were unlikely to be cautious in determining who endorsed the VCR making confusion as to their endorsement greater. Finally, the court concluded that the eighth factor, likelihood of expansion of the product lines, favored White because celebrities often partake in endorsements. Overall, the court held that White raised a valid argument concerning a likelihood of confusion as to her endorsement.

158. The eight-factor test was enunciated in AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979). Because the District Court did not use any of the multi-factor tests in determining whether there was a likelihood of confusion, and because the case involved an appeal from summary judgment, the court reviewed de novo the district court’s determination.
159. White, 971 F.2d at 1400.
160. Id.
161. Id.
162. Id. at 1401. The defendants themselves referred to the ad as the Vanna White ad.
163. White, 971 F.2d at 1400.
164. Id.
165. Id. The court found that the third factor, similarity of the marks, both
Conversely, the likelihood of confusion analysis resulted in a different outcome when it was applied to the facts in *Diana Princess of Wales Mem'l Fund v. Franklin Mint*. Here, the plaintiffs, a fund, the trustees, and an estate, alleged that the defendant made products with images of Princess Diana that were similar to those authorized by her memorial fund. Their argument was that the similar, unauthorized products would create confusion as to whether Princess Diana's Memorial Fund had endorsed the defendant’s products and consequently would receive the proceeds.

In finding for the defendant on the first factor, “strength of the mark,” the United States Court of Appeals for the Ninth Circuit relied on the fact that the plaintiffs used a purple crest to signify authorization of a product. Furthermore, the defendant’s use of Diana’s name and likeness did not expressly indicate an authorization by any organization. Instead, the only message conveyed was that the profits from the defendant’s products would be donated to a charity that the Princess supported.

In considering the eighth factor, the “degree of purchaser care,” the court concluded that the relative cost of the defendant’s merchandise and the publicity surrounding the Fund, made it more supported and contradicted a finding of likelihood of confusion. The marks were similar because all of the aspects of the robot identified White, however, the figure was clearly a robot and not a human. Actual confusion, the fourth factor, did not favor White because she presented no evidence of actual confusion. The fifth factor, marketing channels used, favored White. Magazines were used as the marketing channels for the robot ad. White had appeared in the same stance as the robot in numerous magazines.

166. *Diana Princess of Wales Mem'l Fund v. Franklin Mint Co.*, No. 98-56822, 1999 U.S. App. Lexis 34568 (9th Cir. 1999). The court dismissed the plaintiffs right of publicity claim because England did not recognize a right of publicity much less a postmortem right. *Id.* at *4.

167. *Id.* at *1.

168. *Id.* at *5.

169. *Id.* at *6.


171. *Id.*

172. The degree of purchaser care is synonymous with “the sophistication of relevant buyers.”
likely that consumers would exercise a greater degree of care in selecting products.\textsuperscript{173}

The court also found in favor of the defendant regarding the sixth factor, the defendant’s intent.\textsuperscript{174} The court acknowledged that the defendant may have chosen to market Princess Diana products to capitalize on her celebrity. However, the court was not convinced that the defendant tried to suggest endorsement by the Princess or her estate.\textsuperscript{175} Overall, the court found that the plaintiffs failed to demonstrate that the defendant’s conduct created a likelihood of confusion.\textsuperscript{176}

\textbf{D. Unfair Competition}

Though it is clear that unfair competition is a commercial tort,\textsuperscript{177} a more comprehensive definition of this term is difficult to find. Rather than adhering to a bright line rule, the courts often will consider whether the acts complained of were fair or unfair.\textsuperscript{178} There is no list of conduct that results in a finding of unfair competition.\textsuperscript{179} When Congress passed the Federal Trade Commission Act of 1914, it expressly considered and rejected the suggestion that it clarify the ambiguity of “unfair methods of competition” by enumerating unfair practices.\textsuperscript{180} Congress explained that it would be impossible to frame definitions that

\begin{itemize}
\item \textsuperscript{173} Id. at *9.
\item \textsuperscript{174} Id.
\item \textsuperscript{175} Id.
\item \textsuperscript{176} Diana, 1999 U.S. App. Lexis 34568 at *11.
\item \textsuperscript{177} See J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition § 1:8, at 1-15 (4th ed. 1996).
\item \textsuperscript{178} Id. (The meaning of the term unfair competition is fluid and has been refined on a case-by case basis by lawyers and judges). See McGraw-Hill Book Co. v. Random House, Inc., 225 N.Y.S.2d 646 (1962).
\item \textsuperscript{179} McCarthy, supra note 177, § 1:8, at 1-17. Unfair competition is often cited in complaints that allege trademark infringement. The basis of this cause of action is the public’s confusion as to the source of the goods or services. The facts used to support a claim for trademark infringement are also used to prove unfair competition. See Arvelo v. Am. Int’l. Ins. Co., 875 F. Supp. 95 (1995).
\item \textsuperscript{180} McCarthy, supra note 177, § 1:8, at 1-17.
\end{itemize}
embraced all unfair practices.\footnote{181}{Id. Congress stated that if all known unfair trade practices were specifically defined and prohibited, it would be necessary to begin all over again. See H.R. No. 1142, 63d Cong. (1914).}

The United States Court of Appeals for the Fifth Circuit stated that “unfair competition is the umbrella for all statutory and nonstatutory causes of action arising out of business conduct contrary to honest practice in industrial or commercial matters.”\footnote{182}{See American Heritage Life Ins. Co. v. Heritage Life Ins. Co., 494 F.2d 3 (5th Cir. 1974); Professional Golfers Ass’n v. Bankers Life & Casualty Co., 514 F.2d 665 (5th Cir. 1975). See Rehabilitation Specialists v. Koering, 404 N.W.2d 301, 305 (Minn. Ct. App. 1987) (“Unfair competition is not a tort with specific elements; it describes a general category of torts which courts recognize for the protection of commercial interests”).}

Justice Sandra Day O’Connor gave a more narrow definition of the concept in \textit{Bonito Boats, Inc. v. Thunder Craft Boats Inc.}\footnote{183}{489 U.S. 141 (1989).} Her opinion defined unfair competition as “having its roots in the common law tort of deceit: its general concern is with protecting consumers from confusion as to source.”\footnote{184}{Id.}\footnote{185}{Id.}\footnote{186}{See \textit{MCCARTHY}, supra note 177, §1:10, at 1-23 to 1-24 (providing a more comprehensive list of practices where the courts have found unfair competition).}\footnote{187}{See \textit{RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§46-49 (1993).}} However, Justice O’Connor’s definition has been criticized because source confusion is not the only type of conduct unfair competition was intended to prevent.\footnote{185}{Id.} Other activities labeled unfair by the courts include false advertising, dilution, theft of trade secrets, and infringement of the right of publicity.\footnote{186}{See \textit{MCCARTHY}, supra note 177, §1:10, at 1-23 to 1-24 (providing a more comprehensive list of practices where the courts have found unfair competition).}

Sections 46 to 49 of the Restatement (Third) of Unfair Competition specifically address the applicability of the unfair competition doctrine to the right of publicity.\footnote{187}{See \textit{RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§46-49 (1993).}} Section 46 provides that “one who appropriates the commercial value of a person’s identity by using, without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject
to liability for the relief appropriate." \textsuperscript{188} The Restatement clarifies that a person's identity is used for trade purposes when the "name, likeness or other indicia of a person's identity ... are used in advertising the user's goods or services, placed on merchandise marketed by the user, or are used in connection with services rendered by the user." \textsuperscript{189} The Restatement sets forth certain exceptions to liability, which includes using a celebrity's identity for purposes of news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses. \textsuperscript{190}

\textit{E. Subject Opinion}

On May 28, 2002, T-Shirt Hell filed a lawsuit in the U.S. District Court for the Southern District of New York. The complaint alleged that the defendants, John ("Ozzy") and Sharon Osbourne (Osbournes), as well as several businesses, infringed the company's original trademark, "FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES." \textsuperscript{191} T-Shirt Hell claimed that the defendants, Epic Records and Sony Entertainment, Inc., sent an e-mail requesting five hundred dollars worth of t-shirts displaying the above-mentioned phrase. \textsuperscript{192} Forty t-shirts were sent to the defendants three days after the order was placed. \textsuperscript{193} Approximately two months later, the Osbournes allegedly authorized the manufacture, distribution, and sale of t-shirts bearing a similar phrase. The t-shirt authorized by the Osbournes reads, "Fuck my family ... I'm moving in with the Osbourne family." \textsuperscript{194} The Osbournes also authorized a censored version of the t-shirt. \textsuperscript{195}

\textsuperscript{188} Id. §46.
\textsuperscript{189} Id.
\textsuperscript{190} \textsc{Restatement (Third) of Unfair Competition} §47 (1993).
\textsuperscript{191} See \textit{T-Shirt Hell}, No. 02 CV 4026 at 2.
\textsuperscript{192} Id.
\textsuperscript{193} Id.
\textsuperscript{194} Id.
\textsuperscript{195} Id.
T-Shirt Hell claimed to have notified the defendants of the infringing activity to no avail.\textsuperscript{196} T-Shirt Hell argued that the continued infringement has amounted to unfair competition and irreparable damage.\textsuperscript{197} The company seeks an injunction against the defendants to prevent them from further infringement.\textsuperscript{198} T-Shirt Hell also requested damages in the form of attorney’s fees and lost profits in the amount of fifteen million dollars.\textsuperscript{199} Currently, no answer has been filed.\textsuperscript{200}

### III Analysis

This section will consider the merit of T-Shirt Hell’s trademark infringement and unfair competition claims against the Osbournes.\textsuperscript{201} First, the validity of T-Shirt Hell’s phrase, “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES,” will be evaluated under trademark law. Essentially, this analysis will highlight the shortcomings of T-Shirt Hell’s phrase in terms of its ability to function as a trademark. Second, copyright law will be proposed as a more plausible form of protection for T-Shirt Hell’s phrase.\textsuperscript{202} Here, the company’s phrase will be considered to determine whether it is capable of acquiring copyright protection according to various procedural and statutory requirements.

Third, T-Shirt Hell’s claim of unfair competition will be evaluated.\textsuperscript{203} The defendants’ activities, alleged to be unfair, will be evaluated in light of the Osbournes’ publicity rights. This analysis will lead into the final topic of discussion, which is the problem with seeking protection for a phrase that serves to exploit

\textsuperscript{196} Id.

\textsuperscript{197} See T-Shirt Hell, No. 02 CV 4026 at 3.

\textsuperscript{198} Id.

\textsuperscript{199} Id.

\textsuperscript{200} As of February 24, 2003, a complaint, an amended complaint and various stipulations were the only documents on record for this case.

\textsuperscript{201} See infra notes 205-265 and accompanying text.

\textsuperscript{202} See infra notes 205-218 and accompanying text.

\textsuperscript{203} See infra notes 245-249 and accompanying text.
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the Osbournes' identity.\textsuperscript{204} Here, possible right of publicity counterclaims available to the Osbournes will be discussed. Overall, this analysis will address whether the Osbournes' right to protect their persona would trump any intellectual property right T-Shirt Hell might possess.

\textbf{A. T-Shirt Hell's Trademark Infringement Claim}

In their complaint, T-Shirt Hell claimed that it created the original trademark, "FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES" to be displayed on t-shirts.\textsuperscript{205} The complaint alleged that the defendants' licensing, printing, distribution, and sale of goods displaying a similar slogan, "Fuck my family! I'm moving in with... the Osbourne family," infringed their trademark.\textsuperscript{206} Because T-Shirt Hell's phrase has not been registered, it must be demonstrated that the slogan is entitled to trademark protection for an infringement claim to survive.

\textit{1. T-Shirt Hell's Phrase Fails To Function As A Source Indicator}

Fundamental to trademark protection is the mark's source-signaling capacity.\textsuperscript{207} A critical element in determining whether a term functions as a trademark is the impression that the term makes on the relevant public.\textsuperscript{208} To function as a trademark, the phrase "FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES" would have to convey that T-Shirt Hell is the source of the t-shirt.\textsuperscript{209} Although most of T-Shirt Hell's shirts tend to be offensive in nature, this alone would not make the aforementioned phrase source indicative. Other companies have produced similar offensive t-shirts. Consequently, a court would

\textsuperscript{204} See infra notes 250-265 and accompanying text.
\textsuperscript{205} See T-Shirt Hell, No. 02 CV 4026, at 2.
\textsuperscript{206} Id.
\textsuperscript{207} See supra note 16 and accompanying text.
\textsuperscript{208} See supra note 18 and accompanying text.
\textsuperscript{209} See supra note 16 and accompanying text.
likely categorize T-Shirt Hell’s phrase as mere ornamentation.\textsuperscript{210}

2. \textit{T-Shirt Hell’s Phrase Is Purely Ornamental}

Courts have allowed the registration of ornamental matter if it serves a source indicating function. Ornamental matter can be source indicative if: (1) it names the secondary source of the goods; or (2) at the time of its first use as ornamentation, it was already a recognized trademark of the applicant for services or other goods.\textsuperscript{211} T-Shirt Hell’s phrase is unlikely to satisfy either of these requirements. First, the phrase does not name the source of the t-shirt. Second, prior to its first use in March of 2002, the phrase had not been used on other goods.\textsuperscript{212}

A court is likely to draw a comparison between T-Shirt Hell’s phrase and others that have been deemed merely aesthetically pleasing and ornamental.\textsuperscript{213} A court could find that purchasers of T-Shirt Hell’s clothing are primarily motivated by the funny phrases on the shirts rather than the quality of the good. When a consumer buys a shirt with the phrase “Bin Laden is a big fat doodiehead” printed on the front, it would be difficult to argue that shirt’s fiber count was what ultimately persuaded the buyer. It is more probable that the consumer was motivated to purchase the shirt because of its humorous political statement. The same logic can be applied to the phrase at issue “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES.” Similarly, the prospective purchaser of this shirt is more likely to buy it because of the statement rather than the shirt’s durability.

T-Shirt Hell’s phrase fails to function as a trademark because it does not clearly communicate that T-Shirt Hell is the source of the shirt. Trademark law is designed to prevent consumer confusion in the marketplace. A trademark is the owner’s way of preventing

\textsuperscript{210} When a saying or slogan does not serve as a source indicator, a court is likely to categorize the phrase as mere ornamentation. \textit{See supra} note 25 and accompanying text.

\textsuperscript{211} \textit{See supra} notes 33-34 and accompanying text.

\textsuperscript{212} \textit{See T-Shirt Hell,} No. 02 CV 4026, at 2.

\textsuperscript{213} \textit{See supra} notes 19-34 and accompanying text.
others from tricking consumers into buying a product they mistakenly believe is sponsored by the trademark owner.\textsuperscript{214} However, when there is no source identification, there is no confusion to prevent. Consequently, T-Shirt Hell would be unsuccessful in receiving trademark protection for its phrase.\textsuperscript{215}

3. T-Shirt Hell's Phrase Is Scandalous And Identifies A Living Individual

Even assuming that T-Shirt Hell could establish that its slogan was source-indicative the phrase could still be denied protection on the ground that it is scandalous. \textit{In re Tinseltown} suggests that profanity is likely to be declared scandalous matter.\textsuperscript{216} T-Shirt Hell's phrase contains the word "FUCK" which could present considerable problems under Section 2(a) of the Lanham Act.\textsuperscript{217}

Additionally, T-Shirt Hell's phrase could be precluded because it identifies a living individual. A name is likely to identify an individual if that person is "so well known that the public would reasonably assume the connection, or if the individual is publicly connected with the business in which the mark is used."\textsuperscript{218} The Osbournes are widely known to the American television viewing public. The context of the phrase, which makes reference to the show, makes it even more likely that the name serves to identify the living individuals. Furthermore, the Osbournes have endorsed a variety of merchandise including t-shirts. These similar endorsements increase the likelihood that the public would assume a connection between the celebrity family and the T-Shirt Hell shirt. For the reasons articulated above, T-Shirt Hell would not be persuasive in arguing that its phrase is entitled to trademark protection.

\textsuperscript{214} See \textit{New Kids}, 971 F.2d at 305.
\textsuperscript{215} The right to a particular mark stems from its ability to designate the product of a particular trader. See \textit{supra} note 40 and accompanying text.
\textsuperscript{216} See \textit{supra} notes 45-48 and accompanying text.
\textsuperscript{217} See \textit{supra} notes 43-48 and accompanying text.
\textsuperscript{218} See \textit{supra} notes 55-58 and accompanying text.
B. Copyright: A Better Fit For T-Shirt Hell

A more effective approach would be for T-Shirt Hell to base their complaint on copyright infringement. To establish infringement, T-Shirt Hell must prove two elements: (1) ownership of a valid copyright, and (2) copying of original elements of the work. T-Shirt Hell could easily establish the second element. A plaintiff can establish copying by showing that the defendant had access to the plaintiff’s work and that the works are substantially similar. T-Shirt Hell can demonstrate the defendants’ access to the work by submitting the online order placed by the defendants’ for five hundred dollars worth of the shirts. Substantial similarity can also be established. The defendants’ phrase “Fuck my family... I’m moving in with the Osbourne family” is virtually identical to T-Shirt Hell’s “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES.” Proving the first element of infringement, ownership of a valid copyright, would be more difficult for T-Shirt Hell.

1. T-Shirt Hell Must Establish Ownership Of A Valid Copyright

The 1976 Act provides copyright protection for “original works of authorship fixed in any tangible medium of expression.” Thus, three elements must be present for copyright protection: (1) originality; (2) authorship; and (3) fixation. According to T-Shirt Hell’s complaint, the company invented the phrase “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES”
prior to March 15, 2002.\textsuperscript{225} If this allegation were corroborated, it would establish that T-Shirt Hell independently created the phrase, thereby satisfying the second element of authorship. The third element of fixation is straightforward and is easily satisfied here. Fixation exists "when its embodiment in a copy or phonorecord... is sufficiently permanent... to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."\textsuperscript{226} Here, T-Shirt Hell's phrase is unquestionably fixed by means of the t-shirts.

The first element, originality, could present an obstacle for T-Shirt Hell's phrase. Normally, to be deemed original, the work must be independently created by the author and possess a \textit{minimal} degree of creativity.\textsuperscript{227} As discussed above, independent creation is not a problem here. However, satisfying the requisite level of creativity could present problems for T-Shirt Hell. Normally, a work need only exhibit a minimal degree of creativity for copyright protection. Conversely, the standard is much higher when the phrase is short.\textsuperscript{228} The theory is that "short phrases require less effort from the author" and, therefore, "a greater degree of creativity must be shown in order to claim copyright protection."\textsuperscript{229}

Several courts have denied copyright protection for fragmentary words or phrases due to their lack of creativity.\textsuperscript{230} In most of these cases, the phrase was short and lacked creativity. For example, the United States Court of Appeals for the Second Circuit stated that brand names, trade names, slogans and other short phrases or expressions cannot be copyrighted, even if they are distinctly arranged or printed. \textit{Id}. The court explained that the copyright office does not believe in registering familiar symbols or designs, mere variations of typographic ornamentation, lettering or coloring, and mere listing of ingredients or contents. \textit{Id}. The court conceded that the publication of these views does not have the force of a statute but nonetheless represents a fair summary of the law. \textit{Id}.

\textsuperscript{225} See \textit{T-Shirt Hell}, No. 02 CV 4026 at 2.
\textsuperscript{226} 17 U.S.C. § 101.
\textsuperscript{227} See \textit{NIMMER}, supra note 60, § 1.06[A], at 1-66.28.
\textsuperscript{228} See \textit{Sara Lee}, 266 F.2d at 544. The United States Court of Appeals for the Second Circuit stated that brand names, trade names, slogans and other short phrases or expressions cannot be copyrighted, even if they are distinctly arranged or printed. \textit{Id}. The court explained that the copyright office does not believe in registering familiar symbols or designs, mere variations of typographic ornamentation, lettering or coloring, and mere listing of ingredients or contents. \textit{Id}. The court conceded that the publication of these views does not have the force of a statute but nonetheless represents a fair summary of the law. \textit{Id}.
\textsuperscript{229} There appears to be a reciprocal relationship between creativity and independent effort. See \textit{NIMMER}, supra note 60, §2.01[B], at 2-17.
\textsuperscript{230} \textit{Arica}, 770 F. Supp. 188, at 191-192 (stating copyright protection does
cases the short phrase at issue consisted of only one or two words.\textsuperscript{231} Still, it may be possible for a short phrase to acquire copyright protection if it exhibits sufficient creativity. Jokes, although usually short, have been found to be sufficiently creative in some instances.

2. T-Shirt Hell’s Phrase Could Constitute A Joke

In \textit{Foxworthy v. Custom Tees},\textsuperscript{232} the plaintiff comedian brought an action against the defendant t-shirt manufacturer for allegedly infringing his common-law copyright in the phrase “you might be a redneck” and his copyrighted redneck jokes. The plaintiff explained that the goal in creating a joke is to get the maximum amount of laughter from the shortest amount of material.\textsuperscript{233} Meeting this objective entails constant fumbling with the wording of a joke.\textsuperscript{234} Comedians will debate about which word to put first and which to put last. According to the plaintiff’s testimony, getting the wording correct is key to the success of a joke.\textsuperscript{235}

T-Shirt Hell could try to argue that its phrase exhibits sufficient creativity because it achieves the objective of producing the most amount of laughter from the shortest amount of material. Like the plaintiff in \textit{Foxworthy}, T-Shirt Hell would emphasize the effort that creating a successful joke entails. To bolster its creativity argument, T-Shirt Hell could point to the fact that others, namely the defendants, have copied the phrase.

Although the creativity of a joke is often inherent, jokes remain susceptible to arguments that the expression of the joke has


\textsuperscript{232} 879 F. Supp. 1200 (1995)

\textsuperscript{233} \textit{Id.} at 1218.

\textsuperscript{234} \textit{Id.}

\textsuperscript{235} \textit{Id.}
merged with its idea. Since, copyright law protects expression and not ideas, a merging of the two can be fatal to the joke’s copyrightability. Here, the Osbournes could argue that the value of the phrase “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES” derives from its idea rather than expression. In support, the Osbournes could argue that their show, “The Osbournes,” is one of the most popular shows on television. The popularity of this show is mainly predicated on the ridiculous lifestyle that the family leads. Therefore, the thought of abandoning one’s own family and moving in with the Osbournes is not unique. Essentially, the Osbournes would try to portray T-Shirt Hell’s phrase as one that has become part of the public domain. However, such an argument could prove unsuccessful as it did in Foxworthy.

In Foxworthy, the copyrightability of the plaintiff's redneck jokes was upheld because the plaintiff took those ideas and gave them expression. Therefore, the fact that the plaintiff’s ideas for his jokes came from the public domain was irrelevant. The plaintiff’s motion to enjoin the defendants from further infringement was granted. Similarly, T-Shirt Hell could argue that their company took the idea of shacking up with the Osbournes and gave it expression. Using the same argument as the plaintiff in Foxworthy, T-Shirt Hell would reiterate that the proper ordering of the words is crucial to a joke’s success. T-Shirt Hell’s phrase, like the redneck jokes in Foxworthy, could have value as an expression separate from its idea. As such, the phrase might be entitled to copyright protection as a joke.

Copyright law would provide a stronger basis for seeking relief from the defendants. Unfortunately, T-Shirt Hell did not even

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236. See Nimmer, supra note 60, §2.13, at 2-178.3.
237. See supra notes 98-102 and accompanying text.
238. See supra note 100 and accompanying text.
239. See supra note 101 and accompanying text.
240. See supra note 102 and accompanying text.
241. See supra note 100 and accompanying text.
242. Also favoring T-Shirt Hell is the fact that content restrictions do not exist under copyright law. See supra notes 82-86 and accompanying text.
mention copyright infringement in their complaint. Instead, T-Shirt Hell improperly relied on the law of unfair competition as an additional form of redress.

C. T-Shirt Hell’s Unfair Competition Claim

It is apparent from their complaint that T-Shirt Hell was attempting to use trademark infringement as a basis for claiming unfair competition. However, T-Shirt Hell is unlikely to prevail on either of these claims when considering the facts alleged in their complaint. As discussed earlier, T-Shirt Hell’s phrase is unlikely to qualify for trademark protection. Therefore, the defendant’s activities, no matter how unsavory, would not be characterized as trademark infringement or unfair competition on this ground.

No clear rule has been articulated concerning the conduct that

According to Mitchell, Congress intended that all creative works be accorded protection, reasoning that the public taste would reward creators of useful works and deny creators of useless works any reward. As discussed earlier, T-Shirt Hell’s phrase would be problematic under trademark law because it contains the word “Fuck.” See supra notes 216-217 and accompanying text. The phrase could be precluded, as scandalous matter, under section 2(a) of the Lanham Act. See supra notes 43-48 and accompanying text. Because the phrase identifies living individuals, the Osbournes, it might also face considerable barriers under section 2(c) of the Lanham Act. See supra notes and 55-58 and accompanying text. Lack of content restrictions makes copyright law a more plausible method of protection for T-Shirt Hell’s phrase.

Alternatively, the court could employ the narrower definition of unfair competition articulated in the Bonito Boats decision. See supra notes 183-184. In this situation, T-Shirt Hell would be unsuccessful since its phrase is not source indicative and consequently is not susceptible to confusion in the marketplace.
results in a finding of unfair competition. In evaluating an unfair competition claim, the court might simply consider whether the acts complained of were fair or unfair. If fairness is the standard of review, T-Shirt Hell could try to convince the court that the defendants’ shirt, which bears a nearly identical phrase, has amounted to unfair competition. Blatant copying, under normal circumstances, could be considered an unfair trade practice. Yet this case presents an unusual scenario because of the defendants’ personal ties to the phrase at issue.

The phrase “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES” clearly implicates the celebrity Osbourne family. The fact that the phrase identifies celebrities brings forth a whole host of issues that would not come into play in a typical infringement/unfair competition claim. Because the Osbourne name was appropriated without consent, a court would probably be less sympathetic towards T-Shirt Hell. In fact, a court may be more willing to entertain unfair competition put forth by the Osbournes.

D. The Osbournes’ Rights of Publicity And Unfair Competition Counterclaims

Infringement of the right of publicity is a commercial tort and also a form of unfair competition. Based on the facts of this case, T-Shirt Hell is likely to receive counterclaims for invasion of the Osbournes’ right of publicity and unfair competition. Section 46 of the Restatement (Third) of Unfair Competition provides that “one who appropriates the commercial value of a person’s identity by using, without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability for

248. Id.
249. See McGraw-Hill Book Co. v. Random House, Inc., 225 N.Y.S.2d 646 (1962). See McCarthy, supra note 177, § 1.8, at 1-17. (The meaning of the term unfair competition is fluid and has been refined on a case-by-case basis by lawyers and judges).
250. Id.
the relief appropriate.”

T-Shirt Hell used the Osbourne name for purposes of trade without their consent. To make a prima facie case for infringement, the Osbournes must establish two elements. First, the Osbournes must prove the validity of their right by arguing that their own identity is at issue. Second, the Osbournes must demonstrate infringement. Infringement is established if the defendant, without permission, used some aspect of the identity or persona in such a way as to identify the plaintiff. Additionally, the Osbournes must show that T-Shirt Hell’s use is likely to cause damage to the commercial value of their persona.

Infringement of the right of publicity is governed by the test of “identifiability.” If a significant number of people could identify the Osbournes from T-Shirt Hell’s unpermitted commercial use, infringement would be triggered. No proof of falsity, confusion, or deception is required to prove right of publicity infringement.

251. Restatement (Third) of Unfair Competition §46 (1993). The Restatement clarifies that a person’s identity is used for trade purposes when the “name, likeness or other indicia of a person’s identity . . . are used in advertising the user’s goods or services, placed on merchandise marketed by the user, or are used in connection with services rendered by the user.”

252. The plaintiff’s own identity must be at issue or the plaintiff must be an assignee or exclusive licensee of someone else’s right of publicity. See McCarthy, supra note 120, § 28:7, at 28-9, n.1.

253. The term persona is used refer to the different commercial values embodied in personal identity. Persona encompasses a name, nickname, voice, picture, performing style, distinctive costume or character, and other indicia closely identified with a person. The protected elements of persona may be limited to name and likeness depending on the statute. See McCarthy, supra note 120, § 28:7, at 28-10.

254. Id.

255. Id. Falsity or deception is not required to prove infringement of the right of publicity. Rather, infringement is triggered if the plaintiff is identifiable from the defendant’s unauthorized use. See McCarthy, supra note 120, § 28:12, at 28-14.

256. Id.
1. T-Shirt Hell's Phrase Identifies the Osbournes

It should not be difficult to establish that T-Shirt Hell's phrase identifies the Osbournes. The phrase explicitly uses the Osbourne name in a context that is highly recognizable to the television-viewing public.\(^\text{257}\) The phrase “FUCK MY FAMILY I'M MOVING IN WITH THE OSBOURNES” obviously caters to those familiar with the reality-based television show. The Osbournes could also argue that T-Shirt Hell’s use of their persona caused damage to its commercial value. One way the Osbournes could show damage, although somewhat ironic, is to reference T-Shirt Hell’s complaint. Here, the Osbournes attempted to capitalize on their own success by authorizing the manufacture and distribution of t-shirts bearing the phrase “Fuck my family! I’m moving in with . . . the Osbourne Family.” Yet, it is this conduct that T-Shirt Hell argues was inequitable. Finding in favor of T-Shirt Hell would deprive the Osbournes of their rights to profit off of their own labor.\(^\text{258}\) The Osbournes might also argue that T-Shirt Hell’s exploitation of their persona made their own products less profitable.

2. The Osbournes’ 43(a) Claim

Although falsity is not necessary to establish right of publicity infringement, falsity is required for a 43(a) claim.\(^\text{259}\) Section 43(a) of the Lanham Act prohibits false advertising, which makes it an effective vehicle for alleging claims of false sponsorship and endorsement. Often the unpermitted use of a celebrity’s identity will suggest a false inference of endorsement or sponsorship and hence trigger false advertising concerns in addition to infringing

\(^{257}\) Infringement is established if the defendant, without permission, has used some aspect of identity or persona in such a way that it identifies the plaintiff. See McCarthy, supra note 120, § 28:7, at 28.10.

\(^{258}\) The right of publicity serves to protect against attempts to utilize another’s investment. See Dreyfuss & Kwall, supra note 16, at 519.

\(^{259}\) See McCarthy, supra note 120, § 28:14, at 28-17.
upon the right of publicity.260

The 43(a) analysis is more stringent because it requires the celebrity to prove that the defendant’s appropriation created a likelihood of confusion regarding endorsement. T-Shirt Hell would probably argue that there is no confusion as to sponsorship because their t-shirts are sold from their own web site tshirthell.com. Consequently, the source of the t-shirt is obvious. Still, the Osbournes could defeat T-Shirt Hell’s argument if the eight-factor balancing test were to tip in their favor.261

Looking at the first factor, “strength of the mark,” a court is likely to find that the Osbournes’ celebrity status is strong.262 “The Osbournes” is a very successful television show. As a result, each of the family members has become a star in their own right. The family members have regularly appeared on magazine covers, talk shows, award shows and other highly publicized events. Also favoring the Osbournes is the eighth factor, the “sophistication of the relevant buyers.” Because T-Shirt Hell’s shirts cost only twenty-two dollars each, consumers may not be as cautious in determining sponsorship.263 Here, the strength of the Osbourne mark and the lack of purchaser care make source confusion more probable.

Conversely, the sixth factor, the defendant’s intent, probably

260. Id.

261. The court would use this test to determine whether the defendant’s use of the Osbourne name created confusion as to the endorsement of the t-shirts. This analysis should not be confused with the test used to determine source confusion in trademark infringement actions. Although the tests are very similar, trademark infringement would have required a comparison of T-Shirt Hell’s phrase and the Osbournes’ phrase. Such a comparison is unnecessary here because T-Shirt Hell’s phrase does not function as a trademark. See supra notes 207-218 and accompanying text.

262. When the mark involves a celebrity’s identity the first factor, “strength of the mark,” refers to the level of recognition the celebrity enjoys among members of society. See White, 971 F.2d at 1400.

263. In determining the level of caution buyers are likely to exercise, the court has considered the cost of the product at issue. The theory behind this inquiry is that buyers will be more cautious when the item they are purchasing is expensive. See Diana, 1999 U.S. App. Lexis 34568 at *9.
SUING THE OSBOURNES

Weighs against a finding of confusion. T-Shirt Hell probably did not intend to persuade consumers that the Osbournes had sponsored their shirt. T-Shirt Hell sells their shirts at their own website tshirthell.com. The outcome might be different if the shirts were sold at Mtv.com because of the Osbournes’ strong affiliation with MTV. Fortunately for the Osbournes, there is another factor that favors a finding of confusion. Because celebrities often partake in endorsements, and the Osbournes actually have endorsed a similar shirt, the fourth factor, likelihood of expansion of the product lines weighs in favor of the Osbournes. Thus, it is possible for the Osbournes to prevail on a 43(a) claim for false sponsorship or endorsement.

IV. IMPACT

The T-Shirt Hell case is noteworthy for many reasons. First, it is rare to see a celebrity sued for using his own name. This case is particularly odd because T-Shirt Hell has no contract that entitles them to use the Osbournes’ name or persona. T-Shirt Hell appropriated the Osbourne name without consent, yet still had the audacity to sue the Osbournes so as to prevent them from using their own name in a similar fashion. This case is also unique because it allows for a discussion of a wide range of intellectual property doctrines, which normally would not come into play in a single case.

On a theoretical level, this case is interesting because it presents an equitable predicament. Here, we have a plaintiff who independently came up with a creative phrase that the defendants

264. In determining intent, the relevant question is whether the defendant intended to profit by confusing consumers. Id. at *9-10.

265. The Restatement sets forth some exceptions to liability including the use of a celebrity’s identity for purposes of news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such use. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1993). T-Shirt Hell could try to characterize its use of the Osbourne name as commentary. However, the highly commercial nature of T-Shirt Hell’s appropriation would probably weigh against such a finding.
blatantly copied. On the other hand, we have the defendant Osbournes whose fame and commercially valuable persona have been exploited by the plaintiff without their consent. The irony of the T-Shirt Hell case makes it an interesting topic of debate.

However, the T-Shirt Hell case is noteworthy for another, more important, reason. The T-Shirt Hell case draws attention to the problems inherent in protecting creative merchandise. To an extent, one can sympathize with companies like T-Shirt Hell who have invested considerable time and energy creating profitable merchandise. It seems there should be some way to protect these lucrative t-shirt phrases from the blatant copying and unjust enrichment of others. Still, much uncertainty exists regarding the protectability of creative merchandise. One of the primary reasons for this uncertainty is that creative merchandise and t-shirt phrases do not clearly fall within a specific area of intellectual property.

As will be discussed in the paragraphs that follow, trademark law is a poor fit for creative merchandise. Although copyright law appears more suitable, little precedent exists in this area. However, it is clear that creative merchandise that derives its value from a celebrity’s fame, is at risk under right of publicity law. Right of publicity laws can preclude protection for exploitative merchandise as well as hold the creator liable for damages to the commercial value of the celebrity’s persona.

A. Trademark Law: A Poor Fit For Creative Merchandise

It is unlikely that creative phrases placed on merchandise will ever qualify for trademark protection.266 The t-shirt cases discussed in section II of this article illustrate the courts’

266. The creative phrases at issue here should be distinguished from brand names displayed on merchandise. Brand names placed on merchandise will often qualify for trademark protection if they have source signaling capacity. A brand name is more likely to effectively communicate information about a product or service’s nature and/or quality. Conversely, the aesthetically pleasing text imprinted on the front of a t-shirt, coffee cup, hat or other item of merchandise, does not function in this manner, presenting considerable problems under trademark law. See supra notes 19-58 and accompanying text.
unwillingness to allow trademark protection for creative t-shirt phrases. The courts flat out rejected trademark protection for catchy phrases like “BLACKER THE COLLEGE THE SWEETER THE KNOWLEDGE” and “SWALLOW YOUR LEADER.” In both cases, the court reasoned that such phrases are purely ornamental. In other words, the purchaser ultimately buys the t-shirt because he or she likes the phrase imprinted on it. Though these cases explicitly discuss the protectability of t-shirt phrases, the courts’ holdings are applicable to slogans on all forms of merchandise. In essence, trademark protection will ultimately depend upon the message that the phrase conveys.

To illustrate, consider the T-Shirt Hell phrase “Anna Nicole Ate My Little Brother” imprinted on a t-shirt. This phrase conveys nothing about the t-shirt’s fiber count, fit or durability. Similarly, the phrase printed on a coffee mug does not indicate whether the cup is breakable, microwave-safe or handmade. Rather, the statement “Anna Nicole Ate My Little Brother” simply conveys a humorous message. It is the humorous nature of this expression that probably persuades the consumer to choose that t-shirt or coffee cup over another. As such, the phrase would not function as a trademark but instead, as aesthetically pleasing ornamentation.

The trademark cases clearly indicate that “there is no such thing as a property in trademark except as a right appurtenant to an established business or trade in connection with which the mark is employed.” Simply, the right to a particular mark stems from its ability to designate the product of a particular trader as opposed its

267. See supra notes 19-34 and accompanying text.
268. See supra notes 19-34 and accompanying text.
269. See supra notes 19-34 and accompanying text.
270. See supra notes 19-34 and accompanying text.
271. See supra notes 19-34 and accompanying text.
273. See supra notes 38-40 and accompanying text.
274. See Damn I’m Good, 514 F. Supp. at 1362.
mere adoption.\textsuperscript{275} It is unlikely that the creative phrases at issue will ever serve to designate the product of a particular trader. Thus trademark law proves to be a poor fit for protecting creative merchandise.

\textbf{B. Copyright: A More Plausible Form Of Protection}

Copyright law is more conducive to protecting lucrative phrases. To qualify for copyright protection the phrase at issue must be an original work of authorship that is fixed in a tangible medium.\textsuperscript{276} The inventor of the phrase would need to prove that he or she independently created the expression and that the work has been fixed. Because these phrases are affixed to articles of merchandise, the fixation requirement is easily satisfied.\textsuperscript{277} The authorship and fixation requirements do not present unreasonable challenges for the author. However, satisfying the requisite level of originality could present an obstacle for short phrases.\textsuperscript{278}

Under normal circumstances, a work of authorship need only possess a \textit{minimal} degree of creativity to be deemed original.\textsuperscript{279} However, the standard for short phrases is more substantial requiring a higher level of creativity.\textsuperscript{280} Courts have denied copyright protection for phrases that consist of one or two words, repeatedly citing lack of creativity.\textsuperscript{281} The theory is that short phrases require less effort from the author. Thus a greater degree of creativity must be shown in order to claim copyright protection.\textsuperscript{282}

Most phrases printed on merchandise are relatively short

\textsuperscript{275} Id.
\textsuperscript{276} 17 U.S.C. § 102(a).
\textsuperscript{278} Since short phrases require less effort from the author, a greater degree of creativity must be shown in order to claim copyright protection. See NIMMER, supra note 60, §2.01[B], at 2-16 to 2-17.
\textsuperscript{279} Id. § 1.06[A], at 1-66.28.
\textsuperscript{280} Id § 2.01[B], at 2-16 to 2-17.
\textsuperscript{281} Id. at 2-16.
\textsuperscript{282} Id. at 2-17.
consisting of, at most, a few sentences. The short length of the work weighs against a finding of sufficient creativity. Still, copyright protection for lucrative phrases is not totally out of the question. According to precedent, jokes have been held copyrightable in some instances. The court has recognized the creative efforts involved in writing a successful joke. In creating a joke the goal is to get the maximum amount of laughter from the shortest amount of material. To achieve this objective the author must come up with the proper wording.

Often, a short phrase, taken alone, will lack the requisite creativity for copyright protection. If the phrase, by itself, is insufficiently creative, the author could enhance the originality by including other creative attributes. The merchandise designer could attempt to copyright the t-shirt or article of merchandise as a whole. The author may have a better chance of demonstrating sufficient creativity by pointing to the unique font, color and arrangement of the phrase as it is displayed on the particular article of merchandise.

Still, copyright protection for these types of phrases is uncommon. Instead some t-shirt authors and merchandise designers have improperly relied on the more familiar trademark law as T-Shirt Hell did. Lack of precedent may be due to the high standard of creativity required for short phrases. Another reason may be that because trademarks are often displayed on articles of merchandise, copyright is overlooked. However, mere aesthetic phrases will never acquire trademark status. Despite the lack of precedent, copyright is a more plausible form of protection for creative merchandise.

283. See Foxworthy, 879 F. Supp. at 1200.
284. There appears to be a reciprocal relationship between creativity and independent effort. See Nimmer, supra note 60, §2.01[B], at 2-17.
285. This does not mean that a copyright should be sought for the functional features of the product but rather, for the design as a whole.
287. See supra notes 219-231 and accompanying text.
C. Right of Publicity Issues

As mentioned in the introduction to this Article, the majority of T-Shirt Hell’s shirt phrases derive their humor from celebrity mockery including “Anna Nicole ate my little brother,” “Brittany is a whore,” “Bin Laden is a big fat doodiehead,” and the infamous phrase “FUCK MY FAMILY I’M MOVING IN WITH THE OSBOURNES.” When considering the merchandise on the current market, the exploitation of famous personas is not unique to T-Shirt Hell. T-Shirts, coffee mugs, hats, posters and other items will often depict celebrity images or make reference to a famous name or persona. When the celebrity has not consented to the appropriation, right of publicity laws could present serious obstacles for the companies and individuals who create the merchandise.

As analyzed in Section III of this Article, celebrities have publicity rights. State law determines the scope of these rights and, although they may differ, most states recognize the economic value of a celebrity’s right of publicity. If the author invents a profitable phrase that derives its value from the celebrity’s image, they could be liable for any damage to the commercial value of that celebrity’s persona.\(^{288}\)

V. CONCLUSION

In conclusion, companies like T-Shirt Hell will likely face considerable boundaries to protecting their creative merchandise. Lucrative phrases affixed to merchandise are unlikely to qualify as trademarks. Most often these phrases are merely aesthetic and ornamental. Consequently, such phrases fail to function as source indicators and are not eligible for trademark protection.

Creative merchandise has a better chance of acquiring protection under copyright law. Most phrases will easily satisfy the requirements of authorship and fixation. The additional element, originality, may be a more difficult standard to meet, particularly

\(^{288}\) See supra note 251 and accompanying text.
when the phrase is short. Though the standard of creativity is higher for short phrases, copyright protection is still a possibility. Jokes have been considered sufficiently creative in some instances. If the short phrase, alone, lacks sufficient creativity the author could bolster the insufficiency by attempting to copyright the phrase in conjunction with other creative elements such as font, colors and arrangement. Despite the lack of precedent, copyright appears to be the most plausible way to protect creative merchandise.

Still, companies, like T-Shirt Hell, whose merchandise derives its value from celebrity exploitation and/or mockery could face considerable problems. First, it is unlikely that such phrases, no matter how creative, will ever be granted legal protection. A celebrity’s right of publicity is likely to trump the t-shirt or merchandise creator’s right to sell and protect the profitable goods. Second, the creator of the exploitative phrase could be held liable for damages to the commercial value of that celebrity’s persona. A celebrity’s right of publicity is invaded whenever his identity is exploited for commercial purposes.

Creative merchandise that does not exploit a celebrity may be entitled to copyright protection. Alternatively, T-Shirt Hell, and other companies that earn their livelihood by creating exploitative merchandise, should forget about protecting such phrases. Instead, they should be thankful that the Osbournes, and other celebrities depicted on the company’s shirts, have not filed suit against them.

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